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UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF CALIFORNIA

PRESIDIO COMPONENTS, INC. Plaintiff, v. AMERICAN TECHNICAL CERAMICS CORP., Defendant.	Case No. 3:08-CV-0335 IEG NLS **PRESIDIO COMPONENTS, INC.'S OPPOSITION TO AMERICAN TECHNICAL CERAMICS CORP.'S MOTION FOR SUMMARY JUDGMENT OF INDEFINITENESS**

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I. INTRODUCTION

Dr. Gary Ewell, based on his 45 years of technical experience in the industry, is of the opinion that the claims of United States Patent No. 6,816,356 ("the '356 patent") are definite, are readily understandable by persons of ordinary skill in the field of capacitors, and provide a workable, objective standard for determining the bounds of those claims. When considered with the fact that the '356 patent is presumed definite and valid, which can only be overcome by clear and convincing evidence, the only reasonable determination is that the '356 patent is definite and valid. Despite this overwhelming evidence, Defendant American Technical Ceramics Corp. ("ATC") argues otherwise, and has moved this Court for summary judgment that the '356 patent is indefinite. In view of Dr. Ewell's opinion, the facts surrounding the '356 patent and its claims, and the presumption of validity and definiteness that the '356 patent carries with it, ATC has fallen well short of satisfying its burden of demonstrating that it is entitled to judgment as a matter of law.

That is, ATC has not demonstrated that there are no genuine issues of material fact. ATC also has not demonstrated indefiniteness by clear and convincing evidence. ATC has also not demonstrated that no reasonable jury could return a verdict for Plaintiff Presidio Components, Inc. ("Presidio") that the '356 patent is definite. At most, ATC has raised a question of fact for the jury. For these reasons, as described in more detail below, ATC's Motion for Summary Judgment should be denied.

II. BACKGROUND FACTS

A. The '356 Patent

The '356 patent discloses and claims a novel capacitor consisting of a network of integrated capacitors in series and parallel, for use in wideband frequency applications, including high frequency applications. Hence the title of the '356 patent, an Integrated Broadband Ceramic

Capacitor Array. The integrated array of capacitors is designed in series and in parallel, and in multiple configurations, in order to provide increased capacitance.

As recognized in the '356 patent, ceramic capacitors have been routinely used for decades. (*See* Exhibit A, the '356 patent, at Col. 1, Ln. 23-25). In particular, various monolithic capacitors have been developed to provide capacitors for specific applications. *Id.* at Col. 1, Ln. 63-65. Specific examples of known capacitors, and the industry's knowledge of their design and applications, are set forth in the '356 patent. *Id.* at Figs. 1-8. In sum, capacitors and their applications are well understood by those of ordinary skill in the art.

The patent application that ultimately issued as the '356 patent was filed in April 2003. After the U.S. Patent and Trademark Office extensively reviewed that application, the Patent Examiner determined that the claims of the '356 patent warranted issuance of a patent. Hence, in November 2004, the '356 patent issued. As a matter of law, the U.S. Patent and Trademark Office's decision to issue the '356 patent carries with it a presumption that the claims are valid. In particular, the claims of the '356 patent are presumed definite, and only clear and convincing evidence otherwise can serve to invalidate those claims.

B. The Court Has Evaluated The Claims Of The '356 Patent And Determined Their Meaning Through Its Claim Construction Order

On June 11, 2008, this Court issued its Claim Construction Order, wherein it delineated the legal definition of certain claim terms of the '356 patent. As a part of its Claim Construction Order, the Court thoroughly reviewed the specification and claims of the '356 patent. The Court also thoroughly reviewed the many examples and figures shown in the '356 patent, as well as the definitions proposed by both Presidio and ATC.

Based on this information, the Court was able to, and did, determine the legal definition of the claim terms. In fact, the Court adopted certain definitions proposed by ATC.

Those terms, the definitions of which were proposed by ATC and subsequently adopted by the Court, include terms that ATC now illogically asserts are indefinite. (*See* Docket No. 67, Claim Construction Order).

III. ARGUMENT

A. The '356 Patent And Its Claims Are Presumed Valid And Definite, And Clear And Convincing Evidence Is Required To Prove Otherwise

An issued patent, and each of its claims, is presumed valid. *See* 35 U.S.C. § 282 ("A patent shall be presumed valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims."). Applied here, the '356 patent is presumed valid, and its claims are presumptively valid and definite. *Energizer Holdings, Inc. v. Int'l Trade Commission*, 435 F.3d 1366, 1369 (Fed. Cir. 2006) ("By finding claims indefinite *only if reasonable efforts at claim construction prove futile*, we accord respect to the statutory presumption of validity and we protect the inventive contributions of patentees, even when the drafting of their patents has been less than ideal.") (emphasis added).

Accordingly, ATC has the burden of proving invalidity by clear and convincing evidence. *Aero Prods. Int'l, Inc. v. Intex Rec. Corp.*, 466 F.3d 1000, 1015 (Fed. Cir. 2006) ("A patent is presumed valid, and the burden of establishing invalidity as to any claim of a patent rests upon the party asserting such invalidity. Clear and convincing evidence is required to invalidate a patent."); *see also Typeright Keyboard Corp. v. Microsoft Corp.*, 374 F.3d 1151, 1157 (Fed. Cir. 2004) (same); *AK Steel Corp. v. Sollac & Ugine*, 344 F.3d 1234, 1238-39 (Fed. Cir. 2003) ("[B]ecause a patent is presumed to be valid, the evidentiary burden to show facts supporting a conclusion of invalidity is one of clear and convincing evidence.").

Because ATC has raised the defense of invalidity in connection with a motion for summary judgment, ATC's burden is more than just clear and convincing evidence. Additionally, this Court must "view[ ] the evidence and any disputed factual issues in the light most favorable to the party opposing the motion," who in this case is Presidio. *Enzo Biochem Inc. v. Gen-Probe, Inc.*, 323 F.3d 956, 962 (Fed. Cir. 2002). If there are any underlying questions of material fact, ATC's Motion should be denied. *Freedman Seating Co. v. Am. Seating Co.*, 420 F.3d 1350, 1363 (Fed. Cir. 2005) ("However, it was Freedman who moved for summary judgment. Therefore, American Seating only needed to show the existence of a genuine issue of material fact in order to preclude summary judgment to Freedman."). By way of example only, if there are questions of fact raised by competing expert testimony or evidence, then ATC's Motion should be denied. *Warner-Lambert Co. v. Purepac Pharm. Co.*, 503 F.3d 1254, 1260-61 (Fed. Cir. 2007). In other words, summary judgment is not appropriate if a reasonable jury could return a verdict for Presidio, or if a genuine issue of material fact exists. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986); Fed. R. Civ. P. 56(c).

Here, genuine issues of material fact exist. By way of example only, genuine issues of material fact exist because competent experts have competing opinions. *Warner-Lambert*, 503 F.3d at 1260-61.

B. Definiteness Of Patent Claims

"The definiteness requirement, however, does not compel absolute clarity. Only claims 'not amenable to construction' or 'insolubly ambiguous' are indefinite." *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347 (Fed. Cir. 2005). "If the meaning of the claim is discernable, even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree, we have held the claim sufficiently clear to avoid invalidity on indefiniteness grounds." *Id.* That is, a claim is not indefinite due to alleged ambiguity when the meaning is ascertained from the description in the specification. *Howmedica Osteonics Corp. v. Tranquil Prospects, Ltd.*, 401 F.3d 1367, 1371 (Fed. Cir. 2005) (claim not indefinite due to ambiguity when meaning readily ascertained from the description in the specification). Unless a claim is "insolubly ambiguous," it is not indefinite. *Marley Mouldings, Ltd. v. Mikron Indus.*, 417 F.3d 1356, 1361 (Fed. Cir. 2005). Therefore, "a claim will not be invalidated for indefiniteness without a severe defect." *Fischer-Price, Inc. v. Graco Children's Prods., Inc.*, Case No. 05-1258, 2005 U.S. App. LEXIS 23960, at * 5 (Fed. Cir. Nov. 4, 2005) (attached hereto as Exhibit B); *quoting Exxon Research and Eng'g Co. v. Untied States*, 265 F.3d 1371 1375 (Fed. Cir. 2001).

Claim definiteness focuses on whether those skilled in the art would understand the scope of the claim when the claim is read in light of the rest of the specification. *Howmedica*, 401 F.3d at 1371. A claim that is amenable to construction is not invalid on the grounds of indefiniteness. *Aero Prods.*, 466 F.3d at 1016 ("If a claim is amenable to construction….the claim is not indefinite."); *citing Exxon Research*, 265 F.3d at 1375.

Here, the Court readily construed the claim terms that ATC's contends are indefinite. Further, Dr. Ewell is of the opinion that those skilled in the art would understand the claims of the '356 patent, as defined by this Court, and their scope.

C. Claim 1: "a substantially monolithic dielectric body"

Claim 1 provides in part:

> A capacitor comprising: **a substantially monolithic dielectric body**; a conductive first plate disposed within the dielectric body;…

Use of the claim term "substantially" has repeatedly been held to be proper, and definite. *Ecolab Inc. v. Envirochem, Inc.*, 264 F.3d 1358, 1367 (Fed. Cir. 2001); *Kinzenbaw v. Case LLC*, Case No. 05-1269, 2006 U.S. App. LEXIS 10656, at * 30-31 (Fed. Cir. April 26, 2006) (attached hereto as Exhibit C); *Andrew Corp. v. Gabriel Electronics*, 847 F.2d 819 (Fed. Cir.

1988); *In re Nehrenberg*, 280 F.2d 161 (CCPA 1960); *In re Mattison*, 509 F.2d 563 (CCPA 1975). In fact, the Federal Circuit has noted that:

> the term 'substantially' is a descriptive term commonly used in patent claims to 'avoid a strict numerical boundary to the specified parameter.'

Ecolab, 264 F.3d at 1367; *citing Andrew Corp.,* 847 F.2d at 821-22 (noting that terms such as 'approach each other,' 'close to,' 'substantially equal,' and 'closely approximate' are ubiquitously used in patent claims and that such usages, when serving reasonably to describe the claimed subject matter to those of skill in the field of the invention, and to distinguish the claimed subject matter from the prior art, have been accepted in patent examination and upheld by the courts).

Applied here, the claim term "a substantially monolithic dielectric body" is clear and understandable to one of ordinary skill in the art. Each capacitor contains two conductive contacts and a dielectric material located in between. (*See* Exhibit D, Declaration of Dr. Gary Ewell, at ¶¶ 6-7). During manufacturing, the dielectric body is sintered, fused, or joined to create a single monolithic structure. *Id.* However, there may be internal voids, gaps, or seams remaining within the dielectric body after the fusing or sintering process. *Id.* These voids, gaps, or seams remaining within the dielectric body after fusing or sintering would not detract from the "monolithicity" of the structure. *Id.* The resulting voids, gaps, or seams are well known and understood by one of ordinary skill in the art. *Id.* at ¶ 6.

The '356 patent discloses and claims a novel capacitor consisting of a network or array of integrated capacitors in series and parallel. (*See* Exhibit A, the '356 patent, at Col. 4, Ln. 27-39). The voids, gaps, and seams resulting from the sintering process of an array of capacitors, and the plates within the dielectric, render the use of the claim term "a substantially monolithic dielectric body" appropriate. *Id.* at ¶ 7. That is, when multiple capacitors are sintered, as described and claimed in the '356 patent, the result is voids, gaps, and seams, rendering the structure "substantially monolithic." *Id.* The resultant structure would be considered by one of ordinary skill in the art at the time of the patent application to be monolithic, but to a lesser degree than a single capacitor that has been sintered. *Id.* The use of the phrase "substantially monolithic" then would be understandable to one differentiating between the amount of voids, gaps, and seams expected in a fused single capacitor and the amount of voids, gaps, and seams expected in a fused array of capacitors. *Id.* Therefore, the use of the claim term "substantially monolithic dielectric body" for a fused array of capacitors is clear and understandable to one of ordinary skill in the art. *Id.*

The Court defined the claim term "a substantially monolithic dielectric body" as "a dielectric body largely but not wholly without seams from the inclusion of plates within the dielectric body." This claim term, as defined by the Court (and adopting ATC's proposed construction), is clear and understandable to one of ordinary skill in the art. *Id.* It also provides a workable, objective standard to one of ordinary skill in the art. *Id.* at ¶ 8.

ATC first argues that this claim term is indefinite because the specification does not expressly define it. ATC is wrong, because there is no requirement that the specification provide a definition for each claim term. Rather, all that is required is that one of ordinary skill in the art understand the scope of the claim when the claim is read in light of the rest of the specification. *Howmedica*, 401 F.3d at 1371. As noted above, the scope of this claim term is readily understandable by those of ordinary skill in the art.[1] Further, the Court was able to define it, and it is therefore not indefinite. *Aero Prods.*, 466 F.3d at 1016 ("If a claim is amenable to construction….the claim is not indefinite.").

[1] ATC argues that Dr. Godshalk was unable to apply this claim term to a particular piece of prior art. (ATC's Memorandum, at pp. 6-7). The error in ATC's argument lies in the fact that Dr. Godshalk was asked to apply a definition that was not adopted by the Court.

ATC also argues that this claim term is indefinite because it uses words of degree, *i.e.*, "substantially," and the specification fails to provide a standard for determining what is covered by the claim. (ATC's Memorandum, at p. 4). ATC is wrong here as well. There is nothing improper, or indefinite, in using words of degree. *Ecolab*, 264 F.3d at 1367. This fact is especially true considering that this claim term, as defined by the Court, is clear and understandable to one of ordinary skill in the art (*See* Exhibit D, Declaration of Dr. Gary Ewell, at ¶ 7) and further considering that the specification provides a workable, objective standard to one of ordinary skill in the art (*Id.* at ¶ 8).

The case ATC primarily relies upon in support of its argument, *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342 (Fed. Cir. 2005), does not address the term "substantially," and is readily distinguishable. In *Datamize*, the Federal Circuit upheld the district court's ruling that a particular claim term, *i.e.*, "aesthetically pleasing," was indefinite. The claim term "aesthetically pleasing" described the "look and feel for said interface screens," which was another term in the asserted claim. The Federal Circuit noted that "the definiteness of claim terms depends on whether those terms can be given any reasonable meaning." *Id.* at 1347. Further, the Federal Circuit recognized that "a difficult issue of claim construction does not *ipso facto* result in a holding of indefiniteness." *Id.* Rather, claims are indefinite only if reasonable efforts at claim construction prove futile, because there is a statutory presumption of validity. *Id.*

The claim term "aesthetically pleasing" was logically determined by the Federal Circuit to be "completely dependent upon a person's subjective opinion." *Id.* at 1350. Therefore, the claim term depended solely on the unrestrained, subjective opinion of a particular individual. *Id.* It followed that the meaning of that claim "would depend upon the unpredictable vagaries of any one person's opinion." *Id.*

Here, the claim term "a substantially monolithic dielectric body" is not subjective at all. It is also not dependant upon a particular person's subjective opinion. Rather, the claim term is merely a word of degree. Further, according to Dr. Ewell, this claim term provides an objective standard for determining what is covered by this claim term. (*See* Exhibit D, Declaration of Dr. Gary Ewell, at ¶ 8). Notably, in *Datamize*, the Federal Circuit explained the difference between the improper subjective standard inherent in the claim term "aesthetically pleasing," and a proper objective standard associated with the claim term "substantially," which is properly used as a word of degree. *Id.* at 1351.

D. Claim 1: "the second contact being located sufficiently close to the first contact to form a first fringe-effect capacitance with the first contact"

Claim 1 also provides in part:

> …a conductive first contact disposed externally on the dielectric body and electrically connected to the first plate; and a conductive second contact disposed externally on the dielectric body and electrically connected to the second plate, and **the second contact being located sufficiently close to the first contact to form a first fringe-effect capacitance with the first contact.**

1. There Is An Objective Standard To Determine A Fringe-Effect Capacitance

The behavior of a particular capacitance within the network of capacitors described in the '356 patent will vary based upon the location of the conductors and their relationship to the other capacitances formed. (*See* Exhibit D, Declaration of Dr. Gary Ewell, at ¶¶ 10-11). The behavior may also vary based on the nature of the dielectric material used. *Id.* Depending on these variables, the fringe-effect capacitance may, or may not be, determinable. *Id.* at ¶ 12. That is, there may, or may not be, an effect on insertion loss or data loss. *Id.* If the fringe-effect capacitance is determinable, then it falls within the scope of this claim term. *Id.* If the fringe-effect capacitance is not determinable, then it does not fall within the scope of this claim term. *Id.*

Whether a fringe-effect capacitance is determinable can be tested, and there is an objective, workable standard that one skilled in the art would employ to do so. *Id.* In fact, capacitances and their affects are routinely determined by those of ordinary skill in the art. *Id.* Hence, there is an objective standard to determine a particular capacitance and its affects, and whether such a capacitance would fall within the scope of this claim term. *Id.*

The Court was readily able to define this claim term. The Court's definition is "an end of the first conductive contact and an end of the second conductive contact are positioned in an edge-to-edge relationship in such proximity as to form a determinable capacitance." Therefore, this claim term is not indefinite. *Aero Prods.*, 466 F.3d at 1016 ("If a claim is amenable to construction….the claim is not indefinite."). This claim term, as defined by the Court, and again adopting ATC's proposed construction, is clear and understandable to one of ordinary skill in the art. *Id.* at ¶ 10. It also provides a workable, objective standard to one of ordinary skill in the art. *Id.* at ¶ 12. In particular, if the first and second contacts are close enough such that the capacitance formed affects the insertion or data loss of the network or array of capacitors, then it is determinable and falls within the scope of this claim term. *Id.*

2. The Objective Standard To Determine A Fringe-Effect Capacitance Distinguishes This Claim From The Prior Art

The objective standard by which one of ordinary skill in the art can apply to assess whether the first and second contacts are close enough such that the capacitance formed is determinable, distinguishes the '356 patent from the prior art. For example, there is nothing in the prior art that suggests providing a determinable fringe - effect capacitance as used in connection with Claim 1 of the '356 patent. In particular, there is nothing in the prior art that suggests providing a "second contact being located sufficiently close to the first contact to form a first fringe-effect capacitance with the first contact," that is determinable, as used in association with Claim 1 of the '356 patent. The only prior art ATC can rely upon is theoretical physics - when two contacts exist, there allegedly exists a fringe-effect capacitance between them. Assuming for the moment that this is accurate, which it is not practically, it does not necessarily follow that the fringe-effect capacitance is determinable. *Id.* at ¶ 12.

3. There Is Nothing Improper About Using Functional Limitations

There is nothing inherently wrong with using a functional limitation. *Microprocessor Enhancement Corp. v. Texas Instruments Inc.*, 520 F.3d 1367, 1375 (Fed. Cir. 2008). In fact, as here, it is proper to use functional limitations in connection with a claim directed to an apparatus. *Id.*; *citing K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1363 (Fed. Cir. 1999) (analyzing functional language as an additional limitation to an apparatus claim for an in-line skate). Further, functional limitations are often used in association with an element to define a particular capability or purpose that is served by the recited element. *Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20 (Fed. Cir. 2004).

As noted above, whether a fringe-effect capacitance is determinable can be tested. In fact, capacitances and their effects are routinely tested by those of ordinary skill in the art. (*See* Exhibit D, Declaration of Dr. Gary Ewell, at ¶ 12). Hence, there is an objective standard to determine whether such a capacitance would fall within the scope of this claim term. *Id.* Further, one of ordinary skill in the art would understand the scope of this claim term, based on a review of the '356 patent specification. *Id.* That is all that is required when utilizing functional limitations in connection with a recited claim element. *Microprocessor Enhancement*, 520 F.3d at 1375-76.

4. The "First" Fringe-Effect Capacitance Is Readily Understood By One Of Ordinary Skill In The Art

Here, ATC is clearly fabricating its own ignorance. The claim term at issue provides that the second contact is located sufficiently close to the first contact to form a "first" fringe-effect capacitance with the first contact. By the plain and ordinary meaning of this claim term, the "first" fringe-effect capacitance merely requires that a determinable fringe-effect capacitance be present between the first and second contacts. This may be one of an arbitrary number of fringe-effect capacitors within the network of capacitors. (*See* Exhibit D, Declaration of Dr. Ewell, at ¶ 11). One of ordinary skill in the art would not understand there to be multiple fringe-effect capacitances between the same two contacts at the same location. Rather, one of ordinary skill in the art would understand there to be a single, "first" fringe-effect capacitance between the two contacts at the same location. *Id.* Further, one of ordinary skill in the art would understand that the term "first" fringe-effect capacitance is distinguishing that capacitance from other fringe-effect capacitors within the network of capacitors, including the "second" fringe-effect capacitance utilized in Claim 3. *Id.*

E. Claim 3: "the second contact being located sufficiently close to the first contact on the second side of the dielectric body to form a second fringe-effect capacitance with the first contact"

Claim 3 provides in part:

> The capacitor of claim 1 wherein … **the second contact being located sufficiently close to the first contact on the second side of the dielectric body to form a second fringe-effect capacitance with the first contact.**

As noted above with respect to Claim 1, the term "sufficiently close…to form a first fringe-effect capacitance" provides a workable, objective standard, and is clear and understandable to one of ordinary skill in the art. For the reasons noted above, Claim 3 is equally definite. (*See* Exhibit D, Declaration of Dr. Ewell, at ¶¶ 14-16).

F. Claim 18: "the ceramic body"

Claim 18 depends from Independent Claim 1. The two claims, read in combination, provide as follows:

> Claim 1: A capacitor comprising: a substantially monolithic **dielectric body**;

> Claim 18: The capacitor of claim 1 wherein **the ceramic body** comprises a plurality of ceramic tape layers laminated together in a green ceramic state and fired to form a cured monolithic ceramic structure.

ATC's argument is that the claim term "the ceramic body" lacks antecedent basis. ATC is wrong, and can only take this position by ignoring the obvious – that Dependent Claim 18 and the claim term "the ceramic body," which expressly depends from Independent Claim 1, refers to the "dielectric body" recited in Claim 1. Indeed, ATC indicates that is precisely what the term could be referring to. (*See* ATC's Memorandum, at p. 17, ln. 13-15). ATC then supposes, wildly, that the term could be referring to a new element, *i.e.*, a second ceramic body. *Id.* Given that Claim 18 expressly depends from Claim 1, it can only be referring to elements in that claim. Further, there is nothing else in Claim 1 to which the term "the ceramic body" could refer. Accordingly, based on the plain language of Claim 18, it is clear and unambiguous that the term "the ceramic body" refers to Claim 1, and more specifically, to the "dielectric body" recited in that claim. ATC should not be heard to complain about its own intentional ignorance of the obvious.

Dr. Ewell is of the opinion that one of ordinary skill in the art, having reviewed the '356 patent and the specification, would understand that the term "the ceramic body" refers to Claim 1, and more specifically, to the "dielectric body" recited in that claim. (*See* Exhibit D, Declaration of Dr. Ewell, at ¶ 20). Thus, Dr. Ewell is of the opinion that one of ordinary skill in the art would understand that "the ceramic body" refers to the "dielectric body" recited in Claim 1. *Id.* Accordingly, it is clear and unambiguous to one of ordinary skill in the art that that "the ceramic body" refers to the "dielectric body" recited in Claim 1. Further, the term "the ceramic body" is clear and unambiguous to one of ordinary skill in the art. *Id.*

It should be noted that "the failure to provide explicit antecedent basis for terms does not always render a claim indefinite." See MANUAL OF PATENT EXAMINING PROCEDURE ("MPEP") § 2173.05(e). "If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite." *Id.*; *citing Energizer Holdings*, 435 F.3d at 1369; *see also Ex parte Porter*, 25 U.S.P.Q. 2d 1144, 1145 (Bd. Pat. App. & Inter. 1992). Because the scope of the claim term "the ceramic body" is reasonably understood by those skilled in the art, then the claim is not indefinite.

The sole case cited by ATC in support of its argument is distinguishable. In *Messerschmidt v. United States*, 29 Fed. Cl. 1 (Fed. Cl. 1993), the Court of Federal Claims held that the claim elements "said first and second levers" were indefinite. However, the basis for the decision of the Court of Federal Claims was that there were "no less than seven levers" referred to in the specification, such that the precise levers being referred to could not be determined. *Id.* at 42. Because the claim limitation "said first and second levers" could have been referring to several possible recited elements in the specification, it could not be determined which ones were being referred to. *Id.*

Here, there is no such problem. Given that Claim 18 expressly depends from Claim 1, as opposed to a general reference to the specification, it can only be referring to elements in that claim. Further, there is nothing else in Claim 1 to which the term "the ceramic body" could refer. Accordingly, it is clear and unambiguous that the term "the ceramic body" refers to Claim 1, and more specifically, to the "dielectric body" recited in that claim.

In fact, the *Messerschmidt* decision supports Presidio's position here. In rendering its decision, the *Messerschmidt* court noted as follows:

> However, the Federal Circuit has explained that claims rendered initially indefinite for lack of antecedent basis may nevertheless remain definite when read in light of the specifications. *See Shatterproof Glass Corp. v. Libbey-Owens Ford. Co.*, 758 F.2d 613, 624 (Fed. Cir. 1985) (noting that "the amount of detail required to be included in claims depends on the particular invention and the prior art, and is not to be viewed in the abstract but in conjunction with whether the specification is in compliance with the first paragraph of section 112."), *cert. denied,* 474 U.S. 976, 88 L.Ed. 2d 326, 106 S. Ct. 340 (1985); *Georgia-Pac. Corp. v. United*

> *States Plywood Corp.*, 258 F.2d 124, 136 (2nd Cir.), *cert. denied,* 358 U.S. 884, 3. L.Ed. 2d 112, 79 S. Ct. 124 (1958) (finding "if…read in light of the specifications, [the claims] reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more"). For example, in *Slimfold Mfg. Cor. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1116 (Fed. Cir. 1987), the Federal Circuit deemed a patent with a lack of antecedent valid when read in light of the specifications. In *Slimfold,* the examiner had rejected the patentee's reissue application based on the absence of an antecedent to the claim term "collar." *Id.* at 1114. The Federal Circuit, finding only a single collar in the specification, and then only in a single location, reversed the examiner's rejection because of the obvious intention of the patent drafter when considered in light of the specification. *Id.* at 1117. The court held: "the missing antecedent clause, the absence of which was not observed either by the examiner of the original patent or by [defendant] in its reissue protest documents, did not fail to 'inform the public during the life of the [] patent of the limits of monopoly asserted.'" *Id.* (*quoting Permutit Co. v. Graver Corp.,* U.S. 52, 60, 76 L.Ed. 163, 52 S. Ct. 53 (1931)) (footnote omitted).

Id. at 42.

As in *Slimfold*, the obvious intention of the '356 patent when considered in light of the specification, is that "the ceramic body" refers to Claim 1, and more specifically, to the "dielectric body" recited in that claim. Claim 18 depends upon Claim 1, and therefore "the ceramic body" can only be referring to an element in that claim. Further, there is nothing else in Claim 1 to which the term "the ceramic body" could refer. Thus, any confusion dicussed in *Messerschmidt* is not present here.

G. Claim 19: "the dielectric body has a hexahedron shape"

Claim 19 depends from Independent Claim 1:

> The capacitor of claim 1 wherein **the dielectric body has a hexahedron shape**;…

ATC fabricates its own ignorance here as well, and in doing so completely ignores that claims terms must be interpreted in view of the specification. *Vitronics Corp. v.*

Conceptronics, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996). While the subject of Claim 19 must have a hexahedron shape, it must necessarily also serve as a capacitor. Claim 19 depends from Claim 1, and both are directed to a capacitor. In sum, this claim term defines a structure that is a capacitor, and has a hexahedron shape.

A capacitor with a hexahedron shape would be understood by one of ordinary skill in the art to refer to a capacitor with at least six sides. (*See* Exhibit D, Ewell Declaration, at ¶ 18). This is further demonstrated through the examples provided in the '356 patent. *Id.* Further, one of ordinary skill in the art would have experience that typical monolithic dielectric capacitors have at least six sides. *Id.* That is because all of the US - manufactured monolithic dielectric bodies that are commercially available have at least six sides. *Id.* None of the US-manufactured monolithic dielectric capacitors have only six sides in an extremely precise sense; they usually have very minor additional sides formed by the surfaces of external conductive layers as they are fused to the dielectric body or by small, surface defects, such as "chip outs" or "spalls" in the body that may or may not be covered by the external conductive layers. *Id.*

A capacitor with six sides is not inconsistent with a capacitor with at least six sides. That is, a capacitor with six sides, along with minor additional sides formed by the surfaces of external conductive layers as they are fused to the dielectric body or by small, surface defects, such as "chip outs" or "spalls" in the body that may or may not be covered by the external conductive layers, still has six sides. It follows that one of ordinary skill in the art would readily understand to what this claim term is referring. *Id.* One of ordinary skill in the art would also understand this to be an objective standard to determine the scope of what falls within this claim limitation. *Id.*

IV. CONCLUSION

For the foregoing reasons, Presidio respectfully requests the Court to deny ATC's Motion for Summary Judgment. At most, there are issues of fact relating to the definiteness of the claims of the '356 patent. In view of the competing expert testimony and evidence raised, and the resulting factual dispute, the issue should be presented to the jury.

Dated: July 11, 2008

Respectfully submitted,

WOOD, HERRON & EVANS L.L.P.

By: /s/ Brett A. Schatz
Gregory F. Ahrens
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PRESIDIO COMPONENTS, INC.

PROOF OF SERVICE

STATE OF OHIO)
) **ss.**
COUNTY OF HAMILTON)

I am employed in the County of Hamilton, State of Ohio. I am over the age of 18 and not a party to the within action. My business address is: 2700 Carew Tower, 441 Vine Street, Cincinnati, Ohio 45202.

On July 11, 2008, I served **PRESIDIO COMPONENTS, INC.'S OPPOSITION TO AMERICAN TECHNICAL CERAMICS CORP.'S MOTION FOR SUMMARY JUDGMENT OF INDEFINITENESS** on the interested parties in this action by placing a true copy thereof enclosed in a sealed envelope at Cincinnati, Ohio addressed as follows:

Daniel T. Pascucci
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[X] **(BY MAIL AND EMAIL)** The envelope was mailed with postage thereon fully prepaid. As follows: I am "readily familiar" with the firm's practice of collection and processing correspondence for mailing. Under that practice it would be deposited with U.S. postal service on that same day with postage thereon fully prepaid at Cincinnati, Ohio in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if postal cancellation date or postage meter date is more than one day after date of deposit for mailing in affidavit.

[ ] **(BY HAND DELIVERY)** I caused the attached document to be personally delivered to the above named individual.

[ ] **(BY FACSIMILE)** I delivered such document by facsimile to the ABOVE persons at the facsimile telephone numbers listed ABOVE as a courtesy.

[ ] **(FEDERAL)** I declare that I am employed in the office of a member of the bar of this court at whose direction the service was made.

Executed on March 6, 2008 at Cincinnati, Ohio.

/s/ Brett A. Schatz
Brett A. Schatz